

REMARKS

I. Introduction

With the cancellation herein without prejudice of claim 31, claims 24 to 30 and 32 to 55 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claim 24 Under 35 U.S.C. § 102(b)

Claim 24 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2002/0157737 ("Chesnes et al."). It is respectfully submitted that Chesnes et al. does not anticipate the present claim for at least the following reasons.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In other words, to be anticipatory, a single prior art reference must show all of the limitations of the claims arranged or combined in the same way as recited in the claims. Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359 (Fed. Cir. 2008).

Claim 24 relates to a solder alloy based on nickel, including at least the following elements: chromium, cobalt, molybdenum and nickel; and *a combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C*. Support for the amendments may be found in the Specification, e.g., at page 4, lines 1 to 10.¹

Chesnes et al. does not disclose, or even suggest, all of the claimed features of claim 24. Instead, Chesnes et al. merely indicates a braze alloy powder mixture including a low-melt powder composition and a high-melt powder

¹ Withdrawn claims 35, 37, 41, and 43 have been amended herein without prejudice in analogous manner.

composition. Chesnes et al., ¶ 6. In addition, the low-melt powder composition melts at a range of 2100°F +/- 100°F, and the high-melt powder composition melts above 2400°F. Chesnes et al., ¶ 24. Thus, the braze alloy powder mixture of Chesnes et al. does not have a defined melting range, but instead begins melting at about 2000°F (~1093°C) up to an undefined temperature above 2400°F (~1315°C). However, nowhere does Chesnes et al. disclose a combination of palladium, boron, and yttrium configured to set a melting range between about 1200°C to about 1260°C. Therefore, Chesnes et al. does not disclose, or even suggest, the feature of *a combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C*.

Accordingly, Chesnes et al. does not disclose, or even suggest, all of the features included in claim 24. As such, it is respectfully submitted that Chesnes et al. does not anticipate claim 24.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claim 24 Under 35 U.S.C. § 102(b)

Claim 24 was rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Application Publication No. 63-65044 ("Wakushima et al.").² It is respectfully submitted that Wakushima et al. does not anticipate the present claim for at least the following reasons.

Wakushima et al. does not disclose, or even suggest, all of the claimed features of claim 24. Nowhere does Wakushima et al. even refer to a combination of palladium, boron, and yttrium. Therefore, Wakushima et al. does not disclose, or even suggest, the feature of *a combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C*.

Accordingly, Wakushima et al. does not disclose, or even suggest, all of the features included in claim 24. As such, it is respectfully submitted that Wakushima et al. does not anticipate claim 24.

² The Office Action appears to be relying solely on an English-language abstract of Wakushima et al. That English-language abstract bears a date of **September 8, 2009**, and, therefore, that English-language abstract does not itself constitute prior art against the present application. To the extent that the Office Action is relying on the Japanese-language text of Wakushima et al., the Office **must** provide a translation thereof as stated in M.P.E.P. § 706.02(II).

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 25 to 32 Under 35 U.S.C. § 103(a)

Claims 25 to 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chesnes et al. It is respectfully submitted that Chesnes et al. does not render unpatentable the present claims for at least the following reasons.

As an initial matter, claim 31 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 31.

Claims 25 to 30, and 32 depend from claim 24. As more fully set forth above, Chesnes et al. does not disclose, or even suggest, the feature of a *combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C.*

Accordingly, it is respectfully submitted that Chesnes et al. does not disclose, or even suggest, all of the features included in claim 24, from which claims 25 to 30, and 32 depend. As such, it is respectfully submitted that Chesnes et al. does not render unpatentable claims 25 to 30, and 32, which depend from claim 24.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 25 to 27, 31, and 32 Under 35 U.S.C. § 103(a)

Claims 25 to 27, 31, and 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Wakushima et al. It is respectfully submitted that Wakushima et al. does not render unpatentable the present claims for at least the following reasons.

As indicated above, claim 31 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 31.

Claims 25 to 27, and 32 depend from claim 24. As more fully set forth above, Wakushima et al. does not disclose, or even suggest, the feature of a *combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C.*

Accordingly, it is respectfully submitted that Wakushima et al. does not disclose, or even suggest, all of the features included in claim 24, from which claims

25 to 27, and 32 depend. As such, it is respectfully submitted that Wakushima et al. does not render unpatentable claims 25 to 27, and 32, which depend from claim 24.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 25 to 32 Under 35 U.S.C. § 103(a)

Claims 25 to 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over UK Patent Application No. 2 153 845 ("Shaw et al."). It is respectfully submitted that Shaw et al. does not render unpatentable the present claims for at least the following reasons.

As indicated above, claim 31 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 31.

Claims 25 to 30, and 32 depend from claim 24. Shaw et al. does not disclose, or even suggest, all of the claimed features of claim 24. Nowhere does Shaw et al. even refer to a combination of palladium, boron, and yttrium. Therefore, Shaw et al. does not disclose, or even suggest, the feature of *a combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C*.

Accordingly, it is respectfully submitted that Shaw et al. does not disclose, or even suggest, all of the features included in claim 24, from which claims 25 to 30, and 32 depend. As such, it is respectfully submitted that Shaw et al. does not render unpatentable claims 25 to 30, and 32, which depend from claim 24.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claim 33 Under 35 U.S.C. § 103(a)

Claim 33 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shaw et al. and Chesnes et al. It is respectfully submitted that the combination of Shaw et al. and Chesnes et al. does not render unpatentable the present claim for at least the following reasons.

Claim 33 depends from claim 24. As more fully set forth above, neither Shaw et al. nor Chesnes et al., either alone or in combination, discloses, or even suggests, the feature of *a combination of palladium, boron, and yttrium configured to*

set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C.

Accordingly, it is respectfully submitted that the combination of Shaw et al. and Chesnes et al. does not disclose, or even suggest, all of the features included in claim 24, from which claim 33 depends. As such, it is respectfully submitted that the combination of Shaw et al. and Chesnes et al. does not render unpatentable claim 33, which depends from claim 24.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VIII. Rejection of Claim 34 Under 35 U.S.C. § 103(a)

Claim 34 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shaw et al., U.S. Patent No. 4,802,933 (“Rabinkin”), and Wakushima et al. It is respectfully submitted that the combination of Shaw et al., Rabinkin, and Wakushima et al. does not render unpatentable the present claim for at least the following reasons.

Claim 34 depends from claim 24. As more fully set forth above, neither Shaw et al. nor Wakushima et al., either alone or in combination, discloses, or even suggests, the feature of *a combination of palladium, boron, and yttrium configured to set a melting range of the solder alloy in a range of from about 1200°C to about 1260°C*. Rabinkin does not cure the critical deficiencies of Shaw et al. and Wakushima et al.

Accordingly, it is respectfully submitted that the combination of Shaw et al., Rabinkin, and Wakushima et al. does not disclose, or even suggest, all of the features included in claim 24, from which claim 34 depends. As such, it is respectfully submitted that the combination of Shaw et al., Rabinkin, and Wakushima et al. does not render unpatentable claim 34, which depends from claim 24.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IX. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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